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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Accompanying this Response is a Declaration by the Inventor, pursuant to 37 C.F.R. 1.132. Such "declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted ... applicant files the affidavit or other evidence with a request for continued examination (RCE)." M.P.E.P. 716.01. Since a RCE was filed, this Declaration is timely and should be considered.

"Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

Status of Claims

Claims 37 – 45 and 56 -63 are pending in the application and have been rejected.

In order to more particularly point out and distinctly claim the Invention, Claim 65 has been presented. This claim does not contain new matter.

No other amendments have been made.

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CLAIM REJECTIONS

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected the claims 37 - 45 and 56 – 62 under 35 U.S.C. § 103(a), as being unpatentable over Prokoph (US Patent Publication 2002/0091671) in view of Cole (US Patent 6,571,239) and Kim (US Patent Publication 2003/0208482), and rejected claim 63 under 35 U.S.C. § 103(a), as being unpatentable over Prokoph by Cole by Kim in view of Mattal (US Patent Publication 2004/0261021). Applicant respectfully traverses these rejections in view of the remarks that follow.

In connection with Prokoph, attention is directed to the accompanying Declaration of the Inventor – Einat Amitay. Therein, she compares the herein claimed invention to the principal references (Prokoph and Cole), consistent with the requirement that “An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness.” M.P.E.P. 716.02(e).

Applicant respectfully note that web indexes are not the subject of the herein claimed invention. They were well known and have been used in a multitude of applications. Applicant’s claimed invention operates for any index that contains the complete text of the documents being searched. A web index is just one example of such an index. Claim 65 is now presented to try and highlight the inclusion of the information from the prior queries into an index which indexes the full text of the documents being searched.

In the Advisory action, the Examiner concedes that Prokoph does not disclose adding the information from the queries to the index. Hence, the reference is really not pertinent, as it says nothing about the present invention. Cole adds information from queries to the list of keywords, but not to the index of documents being searched. Here, too, it is not pertinent, as there is no expansion of the index of complete documents to include information from past queries.

The statutory requirement is that “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. 103. Moreover, “As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Determining the Scope and Content of the Prior Art; and
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.” M.P.E.P. 2141.

In her Declaration, the Inventor - Einat Amitay – makes this 3 part analysis and explains why the Invention is not obvious.

A web index refers to an index with complete document information and text, including anchor text and metadata. It certainly does not refer to an index of abstracts of documents or to an index containing only keywords.

Prokoph is creating a new type of index to search which includes just abstracts of the documents, whereas Applicant is searching an index of the complete documents.

Applicant takes the publicly available documents and adds to them the information in past user queries. Prokoph, in contradistinction, creates a new index that contains only abstracts of the documents.

The new and unique element of the invention is “adding information from at least some of said user queries to said complete document index ...” and also “searching said enhanced index of complete documents with user queries upon receipt of an user inquiry.” On Page 4 of the 31 July 2009 Office Action, the Examiner admits that Prokoph does not teach “adding information from at least some of said user queries to said enhanced web index.” Therefore, there is really no reason to consider Prokoph at all. It teaches no more than what Applicant already admitted was known in the art.

Prokoph reduces the size of the index by using only document abstracts. This is the reverse of Applicant. Applicant expands the index, whereas Prokoph reduces it.

Cole also does not work with an index of complete documents or a web index. Cole works with just a keyword index, which does not have the complete document information.

The Examiner cites Cole for teaching “adding information from at least some of said user queries to said enhanced web index,” but Cole does not make such a disclosure.

Cole does not deal with adding information to a web index or to an index of complete documents. Instead, Cole “provides methods ... which solve the problem of mismatch between the keywords employed by a user in making a query and those assigned by the ... classification system stored in the system's keyword index. ... If in a query session the user is satisfied with the object(s) retrieved from the repository, the system associates the initial keywords(s) with the retrieved object(s). ... The keyword index is modified directly ...” (Column 1, lines 6 - 10).

In particular, Cole is working with a “keyword index” as opposed to an “index” of complete documents. These are two entirely different types of indices with very different purposes.

It is clear that, by the “Repository 115” (Column 3, lines 1 – 39), Cole is referring to what Applicant calls “the index of complete documents”. Instead of adding the query words to Repository 115, Cole adds the query words to his keyword list. Accordingly, it is clear that Cole does not teach or suggest “adding information from at least some of said user queries to said complete document index.” Cole adds nothing to the document index (what he calls a Repository), and certainly not to an index of complete documents.

Moreover, in describing how the system operates, Cole nowhere mentions that an index of complete documents is updated or modified based on the queries. Instead, Cole teaches that either the Master Index or the Auxiliary Index is updated (Column 4, line 54, - Column 5, line 2), but nowhere teaches or suggests that the document index should be updated.

Cole recognizes that they are not updating an index of complete documents (Column 2, lines 40 -67). The summary of their invention states that it is “a method... to modify the associations between objects in the database and keywords in the index, based on keywords

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supplied by the user during a search session.” (Column 2, lines 5 -10) The Master Index is the main keyword index which can be modified by only authorized users. When the system is not used by authorized users, then an Auxiliary Keyword Index is created and modified. In either case, however, the index of information itself is not being changed. Only the keyword index is being changed.

Even if Prokoph, Kim and Cole could be combined, there still would not be a teaching or suggestion of the herein claimed invention. None of them mention at all that information from queries is added to an index of complete documents. Even combining them does not teach this concept.

Moreover, “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. 2143.01. Combining these references changes their principle of operation. Cole teaches adding data to a keyword index and not to an index of complete documents.

“Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. ... Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking.” M.P.E.P. 2145. It seems that the Examiner is using such impermissible hindsight reasoning.

In summary, Prokoph does not mention updating any document index, let alone an index of complete documents, based on words used in a query. Cole discusses updating only keyword indexes. There is no teaching or suggestion of updating any index of complete documents. Claim 65 was added to further highlight this distinction.

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Therein lies the “differences between the claimed invention and the prior art” and no evidence has been presented by the Examiner to establish that it would have been obvious to do this. “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art,” M.P.E.P. 2141, and the Examiner has failed to make this showing.

Accordingly, Applicant asserts that Prokoph in combination with Cole and Kim neither teaches nor suggests the limitations of claims 37 or 56 or 65. Accordingly, Applicant respectfully asserts that independent claims 37, 56 and 65 are allowable. Claims 38 – 45 and 57-63 depend from, directly or indirectly, claims 37 and 56 and therefore include all the limitations of those claims. Therefore, Applicant respectfully asserts that claims 38 – 45 and 57 – 63 are likewise allowable.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejections and allow all the claims

In view of the foregoing amendments and remarks, the ending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this response to Deposit Account 09-0468.

Respectfully submitted,

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